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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. COBENE II and ERIC HOARAU

Appeal 2009-004789
Application 10/697,037
Technology Center 3700

Decided: September 23, 2009

Before RICHARD E. SCHAFER, SALLY C. MEDLEY and MICHAEL P. TIERNEY, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

Hewlett Packard Development Company L.P. [hereinafter HP], the real party in interest, seeks review under 35 U.S.C. § 134(a) of a Final Rejection of claims 1 and 3-41. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

References Relied on by the Examiner

Garrido	6,213,703	Apr. 10, 2001
Payne	6,273,661	Aug. 14, 2001
Cobene, II et al. [hereinafter Cobene]	2002/0067977	June 06, 2002
Lawton	2003/0086773	May 08, 2003
Bergholtz et al. [hereinafter Bergholtz]	6,799,391	Oct. 05, 2004

Rejections on Appeal

The Examiner rejected claims 1, 11, 12, 15, 16, 19, 22, 23, 32, 33, 36 and 39 under 35 U.S.C. § 102(e) as anticipated by Lawton.

The Examiner rejected claims 3 and 24 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Bergholtz.

The Examiner rejected claims 4, 5, 25 and 26 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Garrido.

The Examiner rejected claims 6-10, 17, 18, 20, 21, 27-31, 37, 38, 40 and 41 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Payne.

The Examiner rejected claims 13, 14, 34 and 35 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Cobene.

All the claims stand or fall together. App. Br. 5-7.

The Invention

HP discloses, referring to HP's figure 3 reproduced below [numbers from figure 3 inserted], a method for binding a text body [320] to a cover [314] with an adhesive [304 & 312] to form a bound document. The method

includes applying [302] an adhesive [304] to a contacting surface [306] of the plurality of sheets [308] of the text body [320] on an individual sheet-wise basis and adhering [310] the plurality of sheets [308] to the cover [314] on an individual sheet-wise basis by making line contact between the contacting surface [306] and the cover [314] and curing the adhesive. The applied adhesive forms a non-zero contact angle with the contacting surface [306]. Spec. ¶¶ 0021-0023.

HP's figure 3 is reproduced below:

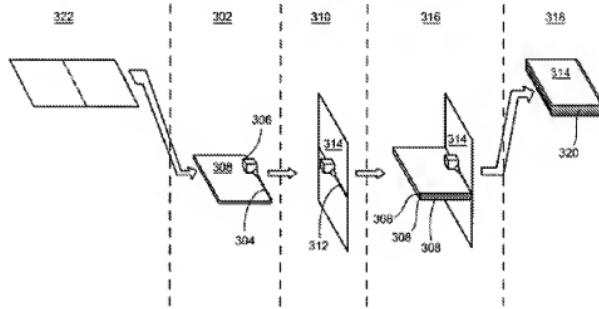


Figure 3 depicts a method for binding a text body to a cover.

Claim 1, reproduced from the Claims Appendix of the Appeal Brief, reads as follows:

A method of binding a text body to a cover with an adhesive to form a bound document, the method comprising:

applying an adhesive to a contacting surface of a plurality of sheets of the text body on an individual sheet-wise basis; and

adhering the plurality of sheets to the cover on an individual sheet-wise basis by making line contact between the contacting surface and the cover and by curing the adhesive, wherein the applied adhesive forms a non-zero contact angle with the contacting surface.

B. ISSUE

Has HP shown that the Examiner incorrectly found that Lawton describes applying adhesive to a contacting surface of a plurality of sheets, adhering the plurality of sheets to a cover by making line contact between the contacting surface and the cover and where the applied adhesive forms a non-zero contact angle with the contacting surface?

C. FINDINGS OF FACT

1. Lawton describes, referring to Lawton's figure 8 reproduced below [numbers from figure 8 inserted], a publication binder [58] and a partially bound publication [100] having pages [102(1 . . . n)] and a cover [104]. Lawton ¶ 0043.

Lawton's figure 8 is below:

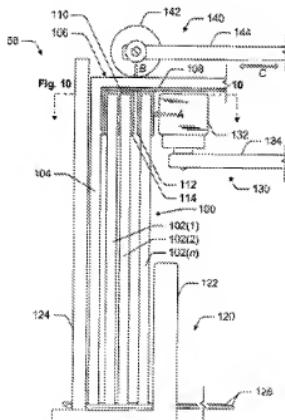


Figure 8 depicts a partially bound publication.

2. The cover [104] has a binding edge [106] to be bound with pages [102(1 . . . n)], and an adhesive [108] on the inside of the cover.
Lawton ¶ 0043.
3. An adhesive [110] is applied to an edge of pages [102(1 . . . n)] to be joined with the adhesive [108] on the inside of the cover [104].
Lawton ¶ 0043.
4. In figure 8, pages [102(1)] and [102(2)] are bound together and page [102(n)] is in a position to be bound with pages [102(1), 102(2)].
Lawton ¶ 0043.
5. The front of page [102(n)] has an adhesive [112] for adhering with the adhesive [114] on the back of page [102(2)].
Lawton ¶ 0043.
6. The publication binder [58] has pressure system [140] to apply a pressure to the binding edge [106] of the cover [104] for a period of time that will adhere the adhesive [108] on the inside of the cover with the adhesive [110] on the edges of the pages [102(1 . . . n)].
Lawton ¶ 0046.
7. Figure 8 depicts the applied adhesive [112 & 114] as forming a non-zero contact angle of approximately 90 degrees with the front and back surfaces of each sheet [102(1 . . . n)].
Lawton fig.8.

D. PRINCIPLES OF LAW

“[A]n indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (citations omitted).

E. ANALYSIS

Anticipation of Claims 1, 11, 12, 15, 16, 19, 22, 23, 32, 33, 36 and 39 by Lawton

Independent claim 1 is representative and recites (disputed limitations in *italics*): “*applying an adhesive to a contacting surface* of a plurality of sheets of the text body *on an individual sheet-wise basis*; and adhering the plurality of sheets to the cover on an individual sheet-wise basis by *making line contact between the contacting surface and the cover . . .* wherein the applied adhesive *forms a non-zero contact angle with the contacting surface.*” App. Br. Claims App’x 1.

The Examiner finds that Lawton describes applying an adhesive [110, 112, 114] to a contacting surface of a plurality of sheets [102] on an individual sheet-wise basis, where the contacting surface includes the top edge and the sides of each sheet [102]. Final Rejection 2-3; Ans. 3-4 (citing Lawton ¶¶ 0043-0045, 0060-0061; figs.8 & 9). The Examiner finds that the top edge portion of each sheet [102] is adhered to a portion [106] of the cover [104, 106] in a line connecting the tops of the sheets and the cover [106] on an individual sheet-wise basis. Final Rejection 2-3; Ans. 3-4 (citing Lawton ¶¶ 0043-0045, 0060-0061; figs.8 & 9). The Examiner further finds that the applied adhesive [110, 112, 114] forms a non-zero contact angle with the contacting surface because portions [112] and [114] of the adhesive in figure 8 have a non-zero contact angle of approximately 90 degrees with respect to the contacting surface at the side of the sheets [102] where the adhesive portions end. Final Rejection 2-3; Ans. 3-4.

HP argues that the claimed contacting surface is a surface which makes line contact with the cover, and the applied adhesive forms a non-zero

contact angle with this same contact surface. App. Br. 6; Reply Br. 2. More specifically, HP argues that “it is ‘the’ contacting surface to which the adhesive has been applied that makes ‘line contact’ (not multi-plane contact) with the cover.” Reply Br. 2. HP argues that Lawton does not describe the claim limitations because the adhesive [110, 112, 114] is applied to both an edge which makes line contact with the cover and to adjacent sides of the pages [102]. App. Br. 5-6. Last, HP argues that Lawton’s multi-planar contacting surface can not make line contact with a cover. Reply Br. 2.

HP’s arguments are not commensurate in scope with the claim limitations. Claim 1 is open-ended because it utilizes the transitional phrase “comprising”. “[A]n indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *KCJ*, 223 F.3d at 1356. The claim recitation of “a contacting surface” means one or more contacting surfaces. The claim language further does not explicitly limit the contacting surface or the one or more contacting surfaces to just the edge of each sheet. Nor does the claim language preclude the contacting surface or the one or more contacting surfaces from including the side surfaces of the sheets. Moreover, HP has not directed us to, and we cannot find, where HP’s specification specifically defines or limits the meaning of contacting surface to mean just an edge and not, alternatively or including, the sides of a sheet.

Lawton describes adhesive applied to one or more contacting surfaces of a plurality of sheets; the one or more contacting surfaces include the edge contacting surface of each sheet [102(1 . . . n)] with adhesive [110] applied thereon, the front contacting surface of each sheet [102(1 . . . n)] with adhesive [112] applied thereon and the back contacting surface of each sheet

[102(1 . . . n)] with adhesive [114] applied thereon. Lawton ¶ 0043. Lawton further describes adhering the plurality of sheets [102(1 . . . n)] to the cover [104], [106] by making line contact between the one or more contacting surfaces and the cover [104], [106]; specifically adhering the edge contacting surface of each sheet [102(1 . . . n)] having adhesive [110] applied thereon to the cover [104], [106]. Lawton ¶¶ 0043, 0045. Lawton further describes that the applied adhesive [112], [114] forms a non-zero contact angle with one or more contacting surfaces, in particular the applied adhesive [112], [114] forms an approximately 90 degree contact angle with the front and the back contacting surfaces of each sheet [102(1 . . . n)] having adhesive [112], [114] applied thereon. Lawton fig.8.

HP also argues that the Examiner's finding that adhesive [112] contacts the cover [104] would only be true for the sheet [102(1)] and would not be the case for the plurality of sheets bound to the cover [104]. App. Br. 5.

As explained before, the Examiner's finding that Lawton describes applying adhesive to a contacting surface is not limited to the adhesive [112] applied to the front side of each sheet [102(1 . . . n)], but also includes the adhesive [110] applied to the edge of each sheet [102(1 . . . n)] and the adhesive [114] applied to the back side of the each sheet [102(1 . . . n)]. Lawton describes that the adhesive [110] located at the edge of each sheet [102(1), 102(2), 102(n)] makes contact with the cover [104]. Lawton ¶ 0043.

For all these reasons, HP has not shown that the Examiner erred in finding claims 1, 11, 12, 15, 16, 19, 22, 23, 32, 33, 36 and 39 anticipated by Lawton.

Obviousness of Claims 3-10, 13, 14, 17, 18, 20, 21, 24-31, 34, 35, 37, 38, 40 and 41 over the prior art

Claims 3-10, 13, 14, 17, 18, 20, 21, 24-31, 34, 35, 37, 38, 40 and 41 are ultimately dependent on claim 1. HP does not present arguments specific to the limitations of the dependent claims, but rather contends that the additional references fail to disclose applying an adhesive on an individual sheet-wise basis as recited in claim 1. App. Br. 6-7. For the same reasons as those explained before regarding claims 1, 11, 12, 15, 16, 19, 22, 23, 32, 33, 36 and 39, HP has not shown that the Examiner erred in determining that claims 3-10, 13, 14, 17, 18, 20, 21, 24-31, 34, 35, 37, 38, 40 and 41 would have been obvious over the applied prior art. Specifically, HP has not shown error in the Examiner's finding that *Lawton*; not the additional references, describes applying an adhesive on an individual sheet-wise basis. *Lawton* ¶0043.

F. CONCLUSION

HP has not shown that the Examiner incorrectly found that *Lawton* describes applying adhesive to a contacting surface of a plurality of sheets, adhering the plurality of sheets to a cover by making line contact between the contacting surface and the cover and where the applied adhesive forms a non-zero contact angle with the contacting surface.

G. ORDER

The decision of the Examiner rejecting rejected claims 1, 11, 12, 15, 16, 19, 22, 23, 32, 33, 36 and 39 under 35 U.S.C. § 102(e) as anticipated by *Lawton* is affirmed.

The decision of the Examiner rejecting claims 3 and 24 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Bergholtz is affirmed.

The decision of the Examiner rejecting claims 4, 5, 25 and 26 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Garrido is affirmed.

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The decision of the Examiner rejecting claims 13, 14, 34 and 35 as unpatentable under 35 U.S.C. § 103(a) over Lawton and Cobene is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

KMF

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